

## **Remarks**

The present Amendment is being filed after the expiration of the 3 month shortened statutory period set forth for response in the 7 May 2007 Office Action. A petition for an extension of time and the fees therefore are enclosed herewith. The present Amendment makes no changes to the claims that necessitate additional fees.

### **For the Claims:**

Applicants originally submitted claims 1-20. A first Office Action, dated 6 October 2004, asserted that claims 1-20 were subject to restriction and/or election. A first Amendment, dated 8 November 2004, elected claims 1-19, withdrew claim 20, and added claims 21-29. A second Office Action, dated 9 February 2005, rejected claims 1-15 and 17-29, and objected to claim 16. A second Amendment, dated 9 May 2005, retained claims 1-29 as originally or previously submitted and added claims 30-31. A third, and final, Office Action, dated 11 August 2005, rejected claims 1-16 and 17-31, and objected to claim 16. A third Amendment, dated 11 October 2005, amended claims 1, 10, 11, 15, 19-21, 30, and 31, canceled claims 7, 9, 12-14, 16, and 23, and retained claims 2-6, 8, 17, 18, 22, and 24-29 as originally or previously submitted. A fourth Office Action, dated 23 November 2005 refused entry of the 11 October 2005 third Amendment because it allegedly raised new issues that required further consideration and/or search. Thus, the fourth Office Action maintained the rejection of claims 1-16 and 17-31, and objection to claim 16. A Request for Continued Examination (RCE) was filed 12 December 2005 to enable entry of the 11 October 2005 third Amendment. A fifth Office Action, dated 23 March 06, responsive to the RCE and the 11 October 2005 third Amendment, rejected all

remaining claims, i.e., claims 1-6, 8, 10, 11, 15, 17-22, and 24-31. A fourth Amendment, dated 23 June 2006, amended claims 1, 10, 15, 19, 21, 22, 30, and 31, and retained claims 2-6, 8, 11, 17-18, 20, 24-29 as originally or previously presented. A sixth, and final, Office Action, dated 1 November 2006, maintained the rejection of claims 1-6, 8, 10, 11, 15, 17-22, and 24-31. A fifth Amendment and an accompanying second Request for Continued Examination (RCE) were filed 31 January 2007. The fifth Amendment canceled claims 1-20, 22-23, 24-27, 29, and 31, amended claims 21, 28, and 30, retained claim 24 as previously presented, and added claims 32-27. Accordingly, claims 21, 24, 28, 30, and 32-47 are pending in the application.

Applicants cancel claims 32-34 and 45-47, amend claims 21, 30, 35, 36, and 41, and retain claims 24, 28, 37-40, and 42-44 as previously submitted. Applicants respectfully request reconsideration in view of the modifications to the claims and the following remarks.

The 7 May 2007 Office Action rejects claims 21, 28, 30, 32-33, 35, 38-39, 41-42, and 43 under 35 U.S.C. §102(b) as being anticipated by Kang, U.S. Patent No. 5,807,357. In addition, claim 24 is rejected under 35 U.S.C. §103(a) as being unpatentable over Kang in view of Dykstra et al., U.S. Patent No. 5,935,982 (hereinafter Dykstra). Claims 34 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kang in view of Fried, U.S. Patent No. 5,836,927. Claims 36-37 and 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kang in view of Bertera, U.S. Patent No. 5,368,582, and claims 40 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kang in view of Hewitt.

Independent claim 21 is being amended to include the limitations of claims 32-34 which depended directly or indirectly

from claim 21. Consequently, claims 32-34 are being canceled. Claim 35 which depended from claim 33 and claim 36 which depended from claim 32 are being amended to correct their dependency in accordance with the modifications to claim 21 and the cancellation of claims 32-34. Independent claim 41 is being amended to include the limitations of claims 45-46, which depended directly or indirectly from claim 41. Consequently, claims 45-46 are being canceled. Claim 30 is being amended to correct a minor typographical error. Claim 47 is being canceled because it was identical to claim 40.

Due to the modifications of independent claims 21 and 41 and cancellation of claims 32-33, the rejections of claims 21, 28, 32-33, 35, 38-39, 41-42, and 43 under 35 U.S.C. §102(b) as being anticipated by Kang as set forth in this Office Action are now moot. With respect to claim 33 (now canceled), the Office Action alleges that Kang teaches a mask adapted to be worn around the eyes and comprises a transparent mask face. Applicants concur with this Office Action allegation. However, claim 33 further included the limitation of the one or more fog outlets are formed in the mask face. It should be noted that Kang does not teach of one or more fog outlets being formed in the mask face. Thus, prior to the modification of claim 21, from which claim 33 depended, the rejection of claim 33 as being anticipated by Kang was improper.

Since amended independent claim 21 now includes the limitations of claims 32-34, claim 21 will be discussed in connection with the rejection of claim 34 under 35 U.S.C. 103(a) as being unpatentable over Kang in view of Fried. Similarly, since amended independent claim 41 includes the limitations of claims 45-46, claim 41 will be discussed in connection with the rejection of claims 45-46 under 35 U.S.C. 103(a) as being unpatentable over Kang in view of Bertera.

Independent claim 21 was amended to include the limitations of a device for delivering the medicine, the device including a mask adapted to be worn around the eyes, the mask including a substantially transparent mask face having one or more fog outlets formed in the mask face, the one or more fog outlets being approximately centered on the mask face for placement substantially in front of the eyes. Applicants have discovered that placement of the fog outlets on the mask face, and especially, placement in front of the eyes allows for more directed and more concentrated delivery of the medicine-carrying fog to the eyes. The features of independent claim 21 enables the targeted delivery of the medicine-carrying fog which provides a more effective treatment and less waste of the medicine than prior art devices.

Kang teaches of a nebulizer for delivering a fine spray of eye medication solution to treat the eyes. The Kang nebulizer includes a goggles unit having an air hole and at least one air chamber communicating with the air hole and fitting over the user's eyes. Fried teaches of a device for administering eyedrops from an eyedrop container to the eye of a user. The Fried device includes an eyeglass frame and eyedrop guide attached to the eyeglass frame and adjustable over the user's eye.

This Office Action asserts that Kang discloses all aspects of the claimed invention with the exception of the fog outlets being centered on the mask face. The Office Action further asserts that Fried teaches a mask for administering medication to the eyes in which the outlets for the medication are centered on the mask face, and concludes that it would be obvious to place the outlets of Kang on the mask face as taught by Fried to allow the medication to be administered accurately into the user's eyes.

Evidence indicating that hindsight has been used in making an obviousness rejection is well-established grounds for reversing obviousness rejections. As stated in In re Fritch 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992):

It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention".

Accordingly, the proper evaluation for determining patentability is to consider whether the prior art suggests the desirability of modifications which make the Kang goggles more closely resemble Applicants' invention of amended independent claim 21 of a mask face having one or more fog outlets formed in the mask face, the one or more fog outlets being approximately centered on the mask face for placement substantially in front of the eyes. Moreover, this suggestion must be found in the prior art and not Applicants' specification.

Kang expressly teaches of delivery of the fine spray of medication from a nebulizer into a goggles unit. The nebulizer is attached to the goggles unit, and the fine spray is delivered from the nebulizer into the goggles unit via a passage at a bridge of the goggles unit with openings entering from the sides of the chambers surrounding each eye. This configuration enables the Kang device to be compact. Unfortunately, the Kang device utilizes an undesirably greater quantity of spray and less effective delivery of the medicine-carrying fog to the eyes because it is not delivered through outlet openings that are arranged substantially in front of the eyes. That is, Kang fails to recognize the problem of inefficient delivery of medicine-

carrying fog to the eyes. Accordingly, Kang cannot suggest its solution of providing a mask face having one or more fog outlets formed in the mask face and approximately centered on the substantially transparent mask face for placement substantially in front of the eyes.

Fried teaches of the self-administration of eyedrops through the attachment of an eyedrops guide to the front of an eyeglass frame. More particularly, the Fried eyedrops guide is a distinct structure that is attached to each shield portion 20, 22 of the eyeglass frame generally above a patient's left and right eyes. An eyedrop container attaches to the eyedrops guide, and the eyedrops guide is movable along an arcuate path above the patient's eye (col. 3, lines 59-62).

It is not proper to pick and choose the Fried eyedrops guide and the Kang nebulizer in an attempt to deprecate Applicants' invention. That is, one would not be motivated to somehow modify the Kang nebulizer to include the Fried eyedrops guide because such a modification would yield significant additional structure to the Kang device, thus defeating its purpose of being compact. For example, in order to modify the Kang device in accordance with the teachings of Fried, the modification may include additional structure such as the Fried eyedrops guide and/or some sort of additional conduit between the Kang nebulizer and the eyedrops guide or between the Kang passage at a bridge of the goggles unit and the eyedrops guide. Moreover, in order to arrive at such a modification, a significant and costly redesign of the Kang device would have to be performed utilizing the invention of claim 21 as a guide or template for the redesign. Of course, using the claimed invention as a template for combining prior art references involves hindsight reconstruction which is clearly improper.

It is only Applicant who reveals the problem of medication waste when medicating an individual with a medicine-carrying fog and provides its solution through the invention of amended independent claim 21. Of course, this knowledge taught only by the inventor cannot be utilized against its teacher. For the reasons set forth above, it is not proper to combine the teachings of Kang and Fried in order to deprecate Applicants' invention of amended independent claim 21. Consequently, claim 21 is not obvious and is therefore believed to be allowable. Claims 24, 28, and 35-40 depend directly or indirectly from claim 21 and are believed allowable by reason of dependency. In addition, claim 37 is believed to be allowable for independent reasons which are discussed below in connection with independent claim 41.

Independent claim 41 was amended to include the limitations of dependent claims 45 and 46, now canceled, including a mask adapted for delivering medicine, the mask including one or more fog outlets proximate the eyes, the mask further including a mask frame and substantially rigid hollow ear support members located on opposing sides of the mask frame, the ear support members being adapted to be worn over the ears of the user to support the mask frame in front of the eyes. Independent claim 41 was further modified to include the limitation of claim 46 including the hollow ear support members being interposed between the one or more fog outlets and the one or more atomizers to establish at least a portion of the one or more elongated conduits.

Regarding the rejections of claims 45-46, the limitations of which are now incorporated into claim 41, the Office Action alleges that Kang discloses all aspects of the claimed invention with the exception of the mask having rigid ear supports, the ear supports comprising a portion of the conduits. The Office Action further alleges that Bertera teaches a mask having rigid ear

supports that comprise a portion of the conduits that carry the medication and concludes that it would be obvious to provide the apparatus of Kang with rigid ear supports, as taught by Bertera, to reduce the bulkiness of the apparatus.

Applicants' respectfully assert that hindsight reconstruction, utilizing Applicants' invention as an instruction manual or template, was utilized in an attempt to render Applicants' invention obvious (In re Fritch, supra). In addition, Bertera fails to teach of hollow ear support members being interposed between the one or more fog outlets and the one or more atomizers to establish at least a portion of the one or more elongated conduits, notwithstanding Office Action allegations to the contrary. Accordingly, even if the teachings of Kang and Bertera were improperly combined, the theoretical combination would not render Applicants' invention of amended independent claim 41 obvious.

One would not be motivated to modify Kang to include the Bertera rigid ear supports because the Kang device intentionally utilizes a flexible strap 100 for fastening the goggles unit to the user's head so that the goggles unit fits snugly against the face over the eyes. Substitution of rigid ear supports in lieu of the Kang strap 100 would result in the Kang goggles unit no longer fitting snugly against the face, therefore rendering it less useful for one of its intended purposes.

Moreover, the Kang device has already incorporated a medicine delivery structure in which the nebulizer is mounted to the top of the goggles unit. The fine spray can be readily delivered from the nebulizer to the goggles unit via a passage at the bridge of the goggles unit. There is no motivation in the prior art for modifying the Kang medicine delivery structure to re-route the medicine from the goggles-mounted nebulizer through



hollow rigid ear supports and back to the goggles unit. There is no motivation because Kang already provides a structure for medicine delivery. Additionally, the theoretical modification would result in significant redesign, more complexity, and a less compact configuration of the Kang device with no commensurate improvement in the efficacy of medicine delivery.

Accordingly, the prior art does not provide the requisite motivation or suggestion for making the combination as alleged in the Office Action. Rather, hindsight reconstruction has been improperly employed, utilizing Applicants' claimed invention as a guide or template to piece together the teachings of Kang and Bertera, in an attempt to render obvious Applicants' invention.

In addition, it should be noted that Bertera fails to teach of the rigid ear supports as being hollow or as establishing at least a portion of the one or more elongated conduits through which medicine-carrying fog passes from the one or more atomizers to the one or more fog outlets, as recited in amended independent claim 41. Rather, the Bertera device shown in FIG. 1 clearly includes a fluid port 24 to a container 12 located on the bridge or top portion of an eye-piece 26 of the spectacle-like frame 20. The fluid port 24 is used for filling and emptying the container 12 (col. 5, lines 34-37). The conduit 18 between this container 12 and the Bertera pump 14 is only located in the eye-piece 26 of the frame 20.

The Bertera frame 20 also includes temple members (unnumbered) that supportingly engage a patient's ears (col. 5, lines 14-17). These temple members serve one equivalent function as Applicants' claimed rigid ear supports. That is, both the Bertera temple members and the claimed rigid ear supports hold the frame in position by engaging the patient's ears. However, the Bertera temple members are not structurally equivalent to

Applicants' claimed rigid ear supports because they are not hollow, nor do they form a portion of the conduit for the medicine-carrying fog. Rather, the Bertera temple members merely house the control module 16 that actuates pumps 14 in the eye-piece 26, a battery power source 28, a pulse generator 30, an on-off switch 32, and a control adjustment 34.

Since Bertera fails to teach of hollow ear support members being interposed between the one or more fog outlets and the one or more atomizers to establish at least a portion of the one or more elongated conduits, an improper combination of Kang and Bertera cannot render obvious Applicants' invention of claim 41. Accordingly, claim 41 is believed to be allowable. Claims 42, 43, and 44 depend directly or indirectly from claim 41 and are believed to be allowable by reason of dependency.

In addition, claim 42 includes the limitations of the mask comprising a substantially transparent mask face, and the one or more fog outlets are formed in the mask face, and claim 43 includes the limitation of the one or more fog outlets are approximately centered on the mask face for bilateral placement substantially in front of the eyes. With respect to claim 42, the Office Action alleges that Kang teaches a mask adapted to be worn around the eyes and comprises a transparent mask face. Applicants concur with this Office Action allegation. However, claim 42 further includes the limitation of the one or more fog outlets are formed in the mask face. It should be noted that Kang does not teach of one or more fog outlets being formed in the mask face. Thus, prior to the modification of claim 41, from which claim 42 depends, the rejection of claim 42 as being anticipated by Kang was improper. Nevertheless, claims 42 and 43 are allowable for the reasons set forth in connection with claim 21.

With respect to independent claim 30, claim 30 includes the limitations of providing a mask having a mask face, the mask face having fog outlets approximately centered on the mask face for placement substantially in front of the eyes such that medicine-carrying fog is discharged from the fog outlets to deliver the medicine-carrying fog to the eyes.

Applicants believe that independent claim 30 is allowable for the reasons set forth above in connection with claims 21, 33, and 42. That is, Kang does not provide a mask having a mask face with fog outlets approximately centered on the mask face for placement substantially in front of the eyes. Accordingly, Kang fails to anticipate the invention of independent claim 30. Nor would one be motivated to somehow modify the Kang nebulizer to include such a feature because the modification would yield significant additional structure to the Kang device, thus defeating its purpose of being compact. Moreover, in order to arrive at such a modification, a significant and costly redesign of the Kang device would have to be performed utilizing the claimed invention as a guide or template for the redesign. Of course, using the claimed invention as a template for combining prior art references involves hindsight reconstruction which is clearly improper. Thus, independent claim 30 is believed to be allowable.

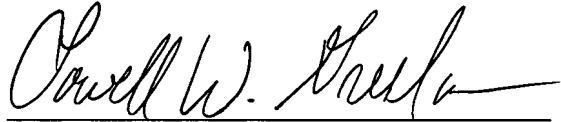
Accordingly, this Amendment cancels claims 32-34 and 45-47 and amends claims 21, 30, 35, 36, and 41. Currently amended claims 21, 30, 35, 36, and 41 remain in the application and are believed to be allowable. In addition, claims 24, 28, 37-40, and 42-44 remain in the application as previously presented and are believed to be allowable.

Applicants believe that the foregoing amendments and remarks are fully responsive to the rejections recited in the 7 May 2007

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Office Action and that the present application is now in a condition for allowance. Accordingly, reconsideration of the present application is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Lowell W. Gresham', written over a horizontal line.

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